

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Lynn Noble Confirmation No.: 3598
Serial No.: 10/776,453 Group Art Unit: 3721
Filed: February 12, 2004 Examiner: Weeks, Gloria R.
For : DISPENSING SYSTEM WITH END SEALER ASSEMBLY AND
METHOD OF MANUFACTURING AND USING SAME

REQUEST FOR SUPPLEMENTAL NOTICE OF ALLOWABILITY

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Notice of Allowability mailed on September 27, 2006, Applicants respectfully request a Supplemental Notice of Allowability based on the discussion below. The issue fee, which comes due on December 27, 2006, has yet to be paid.

Applicants note with appreciation the Examiner's confirmation of allowance in this case. In a review of the Notice of Allowability it is noted that the Examiner has not rejoined claim 30 on the basis that (1) the preamble reference to claim 1 does not overcome the distinction of claim 30 as a separate invention from claim 1, (2) no linking claim is present and (3) "claim 30 was not amended to include the allowable limitations of 1 during prosecution of the application". This criteria for refusing to rejoin claim 30 is respectfully submitted to be in error. In this regard reference is made to MPEP 821.04 and 821.04(b). For convenience an excerpt from MPEP 821.04 and 821.04(b) are set out below (emphasis added).

ARTICLE I.04(b) Rejoinder of Process Requiring an Allowable Product [R-3]

(A) ...821.04 Rejoinder [R-3]

**>The propriety of a restriction requirement should be reconsidered when all the claims directed to the elected invention are in condition for allowance, and the nonelected invention(s) should be considered for rejoinder. Rejoinder involves withdrawal of a restriction requirement between an allowable elected invention and a nonelected invention and examination of the formerly nonelected invention on the merits.

In order to be eligible for rejoinder, a claim to a nonelected invention must depend from or otherwise require all the limitations of an allowable claim. A withdrawn claim that does not require all the limitations of an allowable claim will not be rejoined. Furthermore, where restriction was required between a product and a process of making and/or using the product, and the product invention was elected and subsequently found allowable, all claims to a nonelected process invention must depend from or otherwise require all the limitations of an allowable claim for the claims directed to that process invention to be eligible for rejoinder. See MPEP § 821.04(b). In order to retain the right to rejoinder, applicant is advised that the claims to the nonelected invention(s) should be amended during prosecution to require the limitations of the elected invention. Failure to do so may result in a loss of the right to rejoinder.

Rejoined claims must be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112.

(1) 821.04(b) Rejoinder of Process Requiring an Allowable Product [R-3]

Where claims directed to a product and to a process of making and/or using the product are presented in the same application, applicant may be called upon under 35 U.S.C. 121 to elect claims to either the product or a process. See MPEP § 806.05(f) and § 806.05(h). The claims to the nonelected invention will be withdrawn from further consideration under 37 CFR 1.142. See MPEP § 821 through § 821.03. **However, if applicant elects a claim(s) directed to a product which is subsequently found allowable, withdrawn process claims which depend from or otherwise require all the limitations of an allowable product claim will be considered for rejoinder.** All claims directed to a nonelected process invention must depend from or otherwise require all the limitations of an allowable product claim for that process invention to be rejoined. Upon rejoinder of claims directed to a previously nonelected process invention, the restriction requirement between the elected product and rejoined process(es) will be withdrawn.

The noted MPEP section sets for the eligibility requirements and they are that a non-elected process claim depend from an allowed product claim and that all the limitations of that allowed product claim be included in the process claim to be rejoined. There is not a requirement for an intermediate linking claim (as it is the dependency on an allowed product claim that is controlling – see also MPEP 2116.01 for an additional discussion of this facet of rejoinder). A linking claim would be required if there was lacking dependency in full on an allowed product claim, but that is not the case here.

There is also not a requirement that the process portion of the claim not be directed at a separate invention. MPEP 821.04 specifically recognizes that the elected product and non-elected process fall within different restriction classifications, and thus the restrictions provisions relative to the product/process distinction may still be applicable, but the dependency on an allowable product claim controls.

Lastly the indication “claim 30 was not amended to include the allowable limitations of 1 during prosecution of the application” is not understood. Instant claim 30 includes reference to “claim 1” in its preamble. In other words, the “claim 1” reference in the preamble is to the claim 1 currently allowed. Accordingly, it is not a prior “claim 1” that claim 30 depends from but the currently allowed claim 1 by its reference to “claim 1” in its preamble, and there is not a requirement for an update when the claim refers back to a claim by claim number (which may not be the case where reference back is via incorporation by written inclusion of text directed at each of the claim features from the original product claim, subsequently amended, but that is not the case here).

Also, in the interview leading up to the claim amendments to be made in conjunction with the Notice of Allowability, it was agreed that the claim changes were considered formalistic

in nature and not of the 35 USC 112, second paragraph, rejection type changes (as asserted in the Notice of Allowability discussion). In other words, it was recognized that (and a review of the claim changes confirms) in each instance it is clear what term is being referenced back to in the claim (e.g., “rod” was understood in each instance to refer back to the earlier sole reference to “push rod”). It is thus respectfully submitted that the Supplemental Notice of Allowability confirm that the claim changes made were for formality or cosmetic purposes (or at best objectionable type revisions) and thus were not considered to be “rejectionable” type claim revisions.

Applicants look forward to receipt of a Supplemental Notice of Allowability well prior to the issue fee due date for this application

Respectfully submitted,

SMITH, GAMBRELL & RUSSELL, LLP

By: /Dennis Rodgers/
Dennis C. Rodgers, Reg. 32,936
1850 M Street, N.W., Suite 800
Washington, DC 20036
Telephone: 202/263-4300
Facsimile: 202/263-4329

Date: October 2, 2006